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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/590,873      | 06/08/2007  | Holger Listle        | 10191/4418          | 3733             |

26646 7590 03/01/2010  
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NEW YORK, NY 10004

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| EXAMINER |
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CHEN, SHELLEY

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| ART UNIT | PAPER NUMBER |
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3661

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03/01/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |                                       |  |
|------------------------------|--------------------------------------|---------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/590,873 | <b>Applicant(s)</b><br>LISTLE, HOLGER |  |
|                              | <b>Examiner</b><br>SHELLEY CHEN      | <b>Art Unit</b><br>3661               |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 7-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>8-25-06</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. **Claims 7-13 rejected** under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed invention is a process that is not tied to a particular machine or apparatus, and does not particularly transform a particular article to a different state or thing. Therefore, the claims are non-statutory.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. **Claims 7-8, 10, and 12-13 rejected** under 35 U.S.C. 102(a) as being anticipated by **Barkowski et al.** (DE 10155485, see machine translation).

**Regarding claims 7-8**, Barkowski (see column 3, paragraph 13 to column 7, paragraph 25 and Figures 1-2, etc) discloses the claimed method for enabling navigation data (see title) which is stored on a data carrier (see column 4, paragraph 14, etc), and enabling the useful data for an area which is freely selectable by a user of the useful data (see column 5, paragraph 19 and columns 6 and 7, paragraph 25, etc).

**Regarding claim 10**, Barkowski discloses the claimed use authorization is transmitted via a radio signal (see column 4, paragraph 17, etc).

**Regarding claim 12**, Barkowski discloses the claimed time-limited enabling (see columns 5-6, paragraph 22, etc).

**Regarding claim 13**, Barkowski discloses that the area is not limited to any political boundary as claimed (see column 6, paragraph 23-24, etc).

5. **Claims 7-8, 10, and 12-13 rejected** under 35 U.S.C. 102(a) and (b) as being anticipated by **Thoone et al.** (US 2002/0069360).

**Regarding claims 7-8, 10, and 12-13**, Thoone discloses the claimed method for enabling navigation data (see title) which is stored on a data carrier, and enabling the useful data for an area which is freely selectable by a user of the useful data (see abstract, etc).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. **Claims 9 and 11 rejected** under 35 U.S.C. 103(a) as being unpatentable over **Barkowski et al.** (DE 10155485, see machine translation).

**Regarding claim 9**, Barkowski fails to disclose enabling for an area within a radius around a freely selectable center point. However, it would have been obvious to do so, as commonly known in the art, in order to enable data for only a specific location such as a city that is approximately circular, with predictable results.

**Regarding claim 11**, Barkowski fails to disclose determining whether the user is located within the area for which a use authorization has been granted. However, it would have been obvious to do so, as commonly known in the art, in order to limit authorization only to users within an enabled area, with predictable results.

8. **Claims 9 and 11 rejected** under 35 U.S.C. 103(a) as being unpatentable over **Thoone et al.** (US 2002/0069360).

**Regarding claim 9**, Thoone fails to disclose enabling for an area within a radius around a freely selectable center point. However, it would have been obvious to do so, as commonly known in the art, in order to enable data for only a specific location such as a city that is approximately circular, with predictable results.

**Regarding claim 11**, Thoone fails to disclose determining whether the user is located within the area for which a use authorization has been granted. However, it would have been obvious to do so, as commonly known in the art, in order to limit authorization only to users within an enabled area, with predictable results.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shelley Chen whose telephone number is (571) 270-

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1330. The examiner can normally be reached Mondays through Fridays, between 10:00 AM and 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Black can be reached at (571) 272-6956. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://www.uspto.gov/ebc>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Shelley Chen/

Patent Examiner

Art Unit 3661

February 25, 2010

/Thomas G. Black/

Supervisory Patent Examiner, Art Unit 3661